



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/597,540

02/05/2007

Davide Agnetti

5866

2493

26936 7590 03/10/2010
SHOEMAKER AND MATTARE, LTD
10 POST OFFICE ROAD - SUITE 100
SILVER SPRING, MD 20910

EXAMINER

FONT, FRANK G

ART UNIT

PAPER NUMBER

2872

MAIL DATE

DELIVERY MODE

03/10/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/597,540	Applicant(s) AGNETTI, DAVIDE	
	Examiner FRANK G. FONT	Art Unit 2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-52 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 27, 46, 48-52, is/are rejected.
- 7) ☒ Claim(s) 28-45 and 47 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 July 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/28/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 2872

Detailed Action

Entry of the preamendment filed 7/28/2006 canceled claims 1-26 in favor of new claims 27-52. Thus, claims 27-52 are hereby examined on the merits.

The specification is objected to because of the following informalities:

- 1) specification paragraph [0066], last sentence, the reference numeral 453 should be 452 instead, and
- 2) specification paragraph [0050], "figure 9" should be "figure 12" instead, and
- 3) the recitations "sprung means of fixing" does not seem to be in proper idiomatic English. Is it referring to (tension) "springs"?

Correction is required.

The drawings are objected to because in Fig. 14, one of the two adjustment devices 458 is not labeled (see spec. paragraph [0069]) and in Fig. 15, reference numeral 461 is mislabeled as 461' so that the figure shows two 461' instead of the pair 461, 461' (see spec paragraph [0072]). .

Correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 44-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 44 depends on claim 27 and is adding limitations that are not distinguished from those that are already present in claim 27 (although broadly claimed), so that it is not clear whether they find antecedent is such limitations. For example, is the yoke base of claim 44

Art Unit: 2872

reading on claim 27's "at least one element integrally associable with said optical observation system" or is it "at least one element integrally associable with said pedestal". Also, is the additional "optical observation instrument" of claim 44 reading on the "optical observation system" of claim 27? Claim 45 by virtue of its dependency inherits the problems of claim 44. Claim 46 is indefinite because "said pivoting fulcrum" lacks antecedent basis since claim 27 recites "at least one fulcrum". Claim 47 by virtue of its dependency inherits the problems of claim 46. Additionally, claim 47 recites "the walls of said at least one element..." which lacks antecedent basis in any of its parent claims.

Also regarding claim 44, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 27, 46, 48 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Rand (US Patent No. 3,942,865). Rand discloses (see figure 1 and description) a mounting and adjusting device for an optical observation system comprising an optical observation system (telescope 11) mounted on a pedestal (telescoping pier assembly 45). The device further comprises at least a first element (equatorial axis subassembly 109, 59, 60) integrally associated with the optical observation system (telescope 11) and at least a second element (polar axis

Art Unit: 2872

subassembly 61, 62, 64) integrally associated with the pedestal (telescoping pier assembly 45 through intervening hardware 69-82) wherein the elements are operatively connected to each other in a pivoting manner by two pivoting fulcrums (the polar axis defines the pivoting fulcrum for the equatorial mount subassembly and the pivot pin 86 defines the pivoting axis for the polar mount subassembly). The pivoting axes are mutually transverse to each other and each mount comprises adjustment devices for the pivoting operation (see worm gear 104/motor 105, and clevis assembly 64).

Alternatively, Rand also discloses an additional set of hardware that reads on applicant's claimed device as follows. The first element is disclosed at latitude adjustment section 68 where the hinge pin 76 defines the pivoting axis for the plate 70 which is integrally associated to the telescope (through intervening mounting hardware). The second element is defined by the bottom plate (lower support platform) 69 which rests on upper platform 54 of the pedestal assembly 45 and is rotatable thereon by means of bearing assembly 71. Thus the second element's pivot axis runs concentrically with the pedestal assembly and is therefore transverse to the pivot axis of the first element. Note that the elevating ring 80/worm gear motor 82 is an adjustment mechanism for the first element and the gear teeth of plate 69 together with worm 49 and driving motor 50 constitute an adjustment mechanism for the second element.

Note that the preceding alternative rejections basically set forth the contention that that any telescope employing a polar/equatorial mount as set forth in the first rejection above, or an altitude/azimuthal mount as set forth in the second rejection above would inherently read on all of applicant's claimed subject matter as claimed in claim 1 because by definition, each mount employs orthogonal axes coupling the telescope's support structure to the telescope by way of

Art Unit: 2872

two pivoting axes arranged transversely to each other where each axis is defined by its own fulcrum.

Regarding claim 46, the various screws used as fulcrums already provide a means of restraining as claimed by applicant.

Regarding claim 48, Rand discloses using springs for holding together structural elements.

Regarding claim 49, Rand discloses as stated above an equatorial mounting and an adjustment device (e.g., latitude adjustment device on plate 69) of at least one optical observation instrument (e.g., the telescope 11).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 2872

Claims 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rand (US Patent No. 3,942,865) in view of the non-patent literature reference to

<http://www.stargazing.net/wvas/BigBinocs/Binocular.htm> (hereinafter BigBinocs). Rand

discloses all of the limitations of claims 50-52 (as applied in the preceding rejection) except for the teaching to use a second telescope in place of counterweight 119 of the Fig. 1 embodiment.

The BigBinocs article shows evidence that it was known to use a second telescope in place of a counterweight for counterbalancing the weight of a telescope for several advantageous reasons.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have used a second telescope to counterbalance the first telescope as taught by the BigBinocs article for the purpose of "using two eyes [which] allows for easier viewing and ... a better view" (BigBinocs article, page 2, last paragraph, lines 1-2).

Allowable Subject Matter

Claims 28-45, 47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The specific species limitations set forth in claims 28, 30, 31, 35, 38, 42, 44 and 47 are allowable over the prior art of record. The rest are allowable by virtue of their dependency.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Horvath discloses using vernier adjustments; Tanaka discloses coplanar orthogonal adjustments for an optical device employing a fulcrum. Uehara et al. in figures 17-20 also make use of coplanar orthogonal adjustments for an optical device. Osawa et al. makes use of a tilt

Art Unit: 2872

fulcrum for tilt adjusting a photographed object imaging direction. The article to "Mounts" shows on page 8 a dual telescope counterbalanced system.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK G. FONT whose telephone number is (571)272-2415. The examiner can normally be reached on M-Th 10:00 AM - 8:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Frank G Font/
Primary Examiner, Art Unit 2883

March 2, 2010